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Docket No.: IFT-774 US

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MAIL STOP: APPEAL BRIEF-PATENTS

By: 

Date: March 24, 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Before the Board of Patent Appeals and Interferences

Applic. No.	: 09/867,642	Confirmation No.:	8001
Inventor	: Ilia Zverev et al.		
Filed	: May 30, 2001		
Title	: Method And Virtual Support System for Providing Semiconductor Components and Standalone Simulators Tagged to an Individual Component		
TC/A.U.	: 2128		
Examiner	: Hugh M. Jones		
Customer No.	: 24131		

**BRIEF ON APPEAL**

This is an appeal from the final rejection in the Office action dated September 26, 2005, finally rejecting claims 1-5.

Appellants submit this *Brief on Appeal* including payment in the amount of \$500.00 to cover the fee for filing the *Brief on Appeal*.

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Real Party in Interest:

This application is assigned to Infineon Technologies AG of München, Germany.

The assignment will be submitted for recordation upon the termination of this appeal.

Related Appeals and Interferences:

No related appeals or interference proceedings are currently pending which would directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

Status of Claims:

Claims 1-5 are rejected and are under appeal. No claims have been canceled.

Status of Amendments:

No claims were amended after the final Office action. *A Response under 37 CFR §1.116* was submitted on December 22, 2005. *A Notice of Appeal* was filed on January 30, 2006.

Summary of the Claimed Subject Matter:

As stated in the first paragraph on page 1 of the specification of the instant application, the invention relates to a novel system of providing circuit components together with standalone simulators for the design integration of the circuit components. The invention also relates to a business concept, which aids in shortening and simplifying design cycles for high-tech component integration.

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Appellants described Fig. 1 on page 7 of the specification, starting at line 23. A block 1 represents the research and development division of a component manufacturer and a block 2 represents the marketing, distribution, and technical support division of the same manufacturer.

Appellants outlined on page 8 of the specification, line 4, that research and development R&D, in this context, deals with the development of new components, such as semiconductor chips, which can then be made available for sale through the marketing division 2. The researchers and technicians in charge of the development of the components at 11 are naturally also best equipped to calculate and predict the component behavior in applied circuits (see box 12). This specific know-how, in accordance with the invention, is integrated into a simulator at 13 which is specifically directed to a given semiconductor chip. Preparing such a standalone simulator is quite labor intensive (approximately one-half to a full programmer year). On the other hand, it is considered a relatively straight-forward and simple task to those of skill in the art. Accordingly, the specifics of writing the standalone simulator need not be described in detail herein.

It is further stated on page 8 of the specification, line 21, that the standalone simulator is then listed together with the corresponding component on the externally accessible product marketing page. For example, the customer – or potential customer – accesses the semiconductor manufacturer's web page through the Internet. There, a component catalogue 22 lists the components which are available in inventory 21. The individual components in the component catalogue 22 are

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hyperlinked to the individual standalone simulators, which is available in a simulator directory 23, which is also accessible as an FTP (file transfer protocol) download site. The standalone simulators that are stored in the directory 23 are preferably packaged in archived and compressed format, thus taking up only approximately 1 to 2 MB of space. The completely packaged downloadable simulator file, including the extractable setup files and executable files, can thus be downloaded very quickly. This, of course, is a substantial advantage over the general purpose simulators which take up considerably more space.

As set forth on page 9 of the specification, line 14, the customer 3, that is a current or potential customer such as a product developer who is interested in a given semiconductor component from the component catalogue, selects and downloads the corresponding standalone simulator from the directory 23. The standalone simulator contains the selected components and their combinations, inclusive of the simulation circuit with the parasitic elements of the environment. Then, the archived file downloaded into the customer's computer 31 is extracted and installed at 32. At that point, the customer is ready to run the simulation 33 which is directly geared to the given component and which incorporates the most accurate predictions within the proposed product environment, as well as the discrete components and the expected parasitic behavior.

Appellants explained on page 10 of the specification, line 4, that the parasitic elements have a most essential impact on the success of the simulation.

Disregarding parasitic elements or miscalculations concerning parasitic behavior

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often leads to unacceptable differences between simulations and actual measurements. Here, in accordance with the invention, the simulator has been implemented by experts and it has been adapted to typically application boundaries. The customer thus does not have to build a test circuit and measure the same through a battery of tests.

Appellants further outlined on page 10 of the specification, line 14, that the simulation can be started immediately upon download and installation. The simulation is started with default values and the simulator advantageously offers the user to enter simulation parameters either before running the simulation or even during the simulation.

It is also stated on page 10 of the specification, line 20, that, since the standalone simulator is optimized for the specific purpose, the simulation can run very quickly and with increased numeric stability.

Appellants outlined on page 12 of the specification, line 12, and with reference to Fig. 2, that an exemplary product support page may include a display with a listing of the product catalogue provided by the manufacturer. The individual products – here various MOS chips and MOSFET chips – are linked to simulation models (for those customers that wish to continue using their general purpose simulation programs) and to standalone simulators. The icons are hyperlinked so that the download of a corresponding program can be initiated by clicking. In the exemplary illustration, the customer is interested in the chip MOS3 and he downloads the corresponding

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program Sim3. After installing the simulator program, the product developer is ready to run the simulation, either with the default values or with realtime-variable parameters.

References Cited:

US 6,634,010 B2	Ishigami et al. ("Ishigami")	October 14, 2003
US 6,169,992	Beall et al. ("Beall")	January 2, 2001

Grounds of Rejection to be Reviewed on Appeal

1. Whether or not claims 1-5 are anticipated by Ishigami et al. under 35 U.S.C. §102(a).
2. Whether or not claims 1-5 are anticipated by Beall et al. under 35 U.S.C. § 102(e).

Grouping of Claims:

Claims 1 and 4 are independent. Claims 2 and 3 depend on claim 1. The patentability of claims 2 and 3 is not separately argued. Therefore, claims 2 and 3 stand or fall with claim 1.

Claim 5 depends on claim 4. Claim 5 will not be separately argued from claim 4.

Claim 5 will therefore stand or fall with claim 4.

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**Argument:**

**(1) Claims 1, 2, 3:**

**(A) Claim 1 is patentable over Ishigami:**

The instant application has a filing date of May 30, 2001. Ishigami has a § 102(e) date of June 25, 2001. As such, Ishigami would not be available as a prior art reference against the instant application. The Examiner, however, pointed to In re Epstein, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994) and relied on purported “use” disclosed in Ishigami’s introductory text. The “hearsay rule” of Epstein is clearly not applicable in the instant case. Besides the fact that the dates are entirely wrong, there is no indication that what is purported to have been known was known in this country. The explicit words of 35 U.S.C. § 102(a), of course, require that the prior use and knowledge were in this country. As a matter of fact, the Ishigami disclosure points to Japan as the country of origin.

In detail, Ishigami is not proper prior art because:

(a) The Ishigami patent application was published on Dec. 27, 2001. The instant application was filed May 30, 2001. That is, the Ishigami et al. content was not published before the invention by applicants.

(b) Ishigami describes certain details about use “by others” of something that may or may not be considered the invention. Assuming, *arguendo*, that the “prior art” description in the patent indeed describes the claimed invention, it suggests that the “invention was used by others” not in the United States. The Ishigami disclosure is based on a Japanese priority application. If at all, the “use” of the invention “by others” points to Japan. It is a logical conclusion, by

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the overwhelming weight of the facts before us, that the described "use" was in a country other than the United States.

(c) The statute, 35 U.S.C. § 102(a), is entirely clear: If known or used by others is alleged, it must have been in the United States. If the Office relies on a printed publication, it may be in this or a foreign country.

The patent to Ishigami and its prior use allegations do not carry the Examiner's burden to present a prima facie case. That is, the Examiner has not carried his burden to prove that the invention is unpatentable under § 102(a).

**(1) Claims 4, 5:**

**(B) Claim 4 is patentable over Ishigami:**

Reference is had to the foregoing explanation. Ishigami is not available as a prior art reference. Accordingly, claim 4 is patentable in light of Ishigami.

**(1) Claims 1, 2, 3:**

**(C) Claim 1 is patentable over Beall:**

The invention deals with standalone simulators and with their adaptation to a specific electronic component. Claim 1 calls for a method in which a computer-executable file with a standalone simulator is stored and offered for download and in which the consumer is enabled to execute a simulation in standalone mode.

Beall deals with on-line simulators and catalogs. Beall allows an applet to be downloaded and executed within the user's web browser. The necessary data for display and processing in the applet are provided by the online server. Beall



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describes a system where a part may have "additional information associated with it on the World Wide Web." Col. 15, lines 57-58. When the user clicks on a specific link, an HTML document may be accessed or an applet may be downloaded with executable content. Beall provides an example, namely, "a circuit simulation applet to model the selected integrated circuit's performance." Col. 15, line 66, to col. 16, line 1. Beall goes on to explain that the user may browse the necessary information and choose from additional information.

Any of these associated URLs might also be Java applets, whose launch results in execution of the applet locally within the user's web browser 4014. For example, an output voltage attribute might have an associated HTML page containing an applet that interacts with the user, accepting various input parameters and dynamically graphing the resulting voltage or current curves representing device characteristics. This allows for interactive functionality associated with any database element to be delivered to the user on demand.

Beall, col. 16, lines 12-21 (emphasis added).

It is entirely clear that Beall's user remains connected to the server at all times during the execution of the applet. The applet within the web browser requires additional input that is retrieved in an interactive sense from the server. In this regard, Beall's example is not different from the Transim system that is described in the last paragraph of page 3 of the specification. See also, the reference to McDonald et al. US 6,530,065 B1, of record.

When appellants proffered the foregoing argument following a first rejection, the Examiner took issue and stated that the allegations were "misleading and taken out of context." Office action dated Sept. 26, 2005, page 5. The honorable Board is requested to determine this issue. Appellants are entirely sure that their allegations are not misleading and/or taken out of context. In fact, even the Examiner's

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quotations from Beall clearly indicate that the user is enabled to browse the necessary information and choose from additional information. If nothing else, that disclosure at least suggests that the user remain connected to the Internet.

The user may choose to browse this associated information by choosing to view linked data, resulting in the launch of an instance of a Web browser with the URL.

Beall, col. 16, lines 1-4 (emphasis added). It is clear that the user could not be offered the choice of viewing linked data if he were not connected to the Internet.

The question for this appeal is whether or not Beall also shows or suggests a standalone executable application.

We believe that the reference does not. Beall's preferred system downloads an applet into the web browser. An applet is a Java application program that becomes (temporarily) resident in a web browser and it acts as a user interface. The applet is indeed executable within the web browser, but it still requires additional data (i.e., information content) for processing. Such additional data is brought down through a distributed network, namely, the Internet, a WAN, a LAN, or the like. Beall's user remains connected to the server during the execution of the applet. The applet is not a computer-executable file with a standalone simulator. Beall's program does not execute a simulation in standalone mode.

Intermediate interruptions of the connection are acceptable to Beall. For a certain time, one would assume, the web browser and its applet can execute in off-line mode.

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Such processing is only temporary, however, as the system requires data download that continues during the process. Beall details several routines to handle temporary disconnections. See, for example, the description of Fig. 16 and the related flowchart of Figs. 13A and 13B.

Appellants do not challenge the Examiner's interpretation that Beall explain optional access by the user of additional information ("The user may choose to browse . . ."). The terminology "may choose" indicates that such an option is provided to the user. The option can only be available, of course, if the user is connected to a network such as the Internet. The option could not be offered if the user were truly in standalone mode. Processing information in a browser-resident applet – even if the browser is taken offline temporarily, yet the user retains the option to return to online mode at any time – is not a standalone application.

**(1) Claims 4, 5:**

**(D) Claim 4 is patentable over Beall:**

Claim 4 deals with a product support system in which standalone simulators are stored, offered for download and enabled for execution in standalone mode as a standalone simulator. As Beall does not provide for a standalone simulator and the execution of a simulation in standalone mode, the reference is also lacking with regard to claim 4. Beall does not disclose a storage system within the virtual product support system in which computer-executable standalone simulators are stored with linking information to given components.

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The foregoing arguments with regard to the "standalone" mode of the claimed invention as opposed to the connection and connectability of Beall apply here as well. Accordingly, reference is had to the arguments found above under item (C).

The honorable Board is therefore respectfully urged to reverse the final rejection of the Primary Examiner.

Respectfully submitted,



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Claims Appendix:

1. A method of supporting an electronic component, which comprises:

providing an online catalogue with electronic components;

storing a computer-executable file with a standalone simulator for simulating a circuit behavior of a specific one of the electronic components;

linking the computer-executable file to the specific electronic component in the online catalogue and enabling download of the computer-executable file to a consumer and enabling the consumer to execute a simulation with the specific electronic component in standalone mode.

2. The method according to claim 1, wherein the storing step comprises archiving the computer-executable file and prompting the consumer to extract and install the computer-executable file prior to executing the simulation.

3. The method according to claim 1, which further comprises storing simulation models for the electronic components in the online catalogue and enabling the consumer to download either a simulation model or a standalone simulator linked to a given one of the electronic components.

4. A virtual product support system, comprising:

a computer-readable file with a listing of electronic components;

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a storage system storing computer-executable files with standalone simulators for simulating an electronic behavior of the electronic components;

a computer-readable file with a listing of the standalone simulators available in said storage system and with linking information between individual standalone simulators and individual electronic components; and

a network connection for providing access to said listing of standalone simulators and for enabling download, by a customer, of individual simulators via said network connection.

5. The virtual product support system according to claim 4, wherein said network connection is an Internet connection and said listing of the standalone simulators is hyperlinked to said computer-executable files.

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**Evidence Appendix:**

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or any other evidence has been entered by the Examiner and relied upon by appellant in the appeal.

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Related Proceedings Appendix:

Since there are no prior or pending appeals, interferences or judicial proceedings which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in this appeal, no copies of decision rendered by a court or the Board are available.